

REMARKS

Applicant has amended claim 1 to overcome the objection in paragraph 1 on page 2 of the Action. Although applicant appreciates the Examiner's constructive suggestion, applicant believes that the subject matter of claim 1 as amended more accurately reflects the broadest aspects of the claimed invention. Applicant has also amended claim 2 to introduce more conventional language and has added new claims 13-17 that are directed to the invention as the Examiner kindly suggested it be described. These amendments do not narrow the scope of the claims in any way and thus do not introduce new matter into the application. Furthermore, the new claims are not directed to an independent and distinct invention so as to justify their withdrawal from consideration under the doctrine of constructive election. Entry of these amendments and withdrawal of the objection to claim 1 are respectfully requested.

Claims 1-12 stand rejected under 35 USC 112, second paragraph, as indefinite in referring to projections pointing in a tensioning direction or recesses for holding the intervertebral endoprosthesis, the Examiner alleging that the claims are "indefinite because it is unclear which structure should be included in the claimed invention." The Examiner also rejects claim 8 as indefinite in reciting "the projections," arguing that claim 8 is indefinite because claim 1 states that the structure could be recesses instead of projections. This rejection and its supporting reasoning are respectfully traversed.

There is nothing whatever wrong with claims setting forth inventions in the alternative. Under claim 1 as amended, even as construed by the Examiner, the invention could include projections on the gripping members that point in a clamping direction or recesses on the gripping members for holding the intervertebral prosthesis against forces in the clamping direction. Applicant respectfully suggests that the Examiner consider MPEP 2173.05(h).II, which specifically indicates that alternative expressions using "or" are acceptable. Applicant also points out that claim 8 further modifies the subject matter of claim 1 in the case where the invention uses projections instead of recesses and that persons skilled in the art would clearly understand that claim 8 refers to only cases in which projections are used in the invention. The

rejection of claims 1-12 as indefinite under 35 USC 112, second paragraph, should be withdrawn.

Claims 1-3 and 6 stand rejected as anticipated by Moskovich. The Examiner also rejected claims 4, 5 and 7-12 as obvious on combinations of references including Moskovich in which Moskovich is cited for the teachings for which the Examiner cites it as anticipating claims 1-3 and 6. The Examiner reads Moskovich as disclosing the device including two closure plates 11, 12 connected by hinge 13, as illustrated in Figure 4. The closure plates have gripping members with grooved surfaces as shown in Figure 3 for supporting the prosthesis. The Examiner views the proximal ends of Moskovich's plates as being capable of functioning as hand grips. The Examiner reads Figure 6 as showing the hinged gripping plates, 1, 2 connected to an actuating device 21 which includes a threaded rod 25 with a handle 22 that could also function as a force receiving part or strike head. The Examiner considers that block 26 at the end of the rod is positioned between the gripping members 1, 2 and is moved longitudinally by the actuating device to bear on a prosthesis 5. These rejections and their supporting reasoning are respectfully traversed.

As is clear from amended claim 1 above, this invention as broadly claimed is directed to an insertion instrument that is separate from the closure plates and sliding core that comprise the endoprosthesis. This is still true with respect to new claims 13-17. Applicant respectfully suggests that the Examiner has not properly differentiated the claimed insertion instrument from the endoprosthesis being inserted.

Moskovich discloses a pair of guides 1 and 2 inserted between two vertebrae 3 and 4, with bone graft 5, the endoprosthesis, shown as being ready for insertion between the vertebrae. Applicant notes that bone graft 5 is not a sliding core as set forth in the claims in this application. Enclosure plates 1, 2 do not constitute the claimed insertion instrument.

As the claims in this application as amended require, in this invention the projections or recesses, whichever are used, are configured so that actuation of the block will secure the endoprosthesis against the projections or recesses in a tensioning direction that is different from

the clamping direction of the gripping members. Moskovich not only fails to disclose this feature of the invention, it suggests that a significantly different structure be provided. The Examiner refers to the grooved surfaces shown in Fig. 3 as supporting the prosthesis, citing col. 3, lines 1-7, of Moskovich as explaining this disclosure. These grooved surfaces, however, extend in a direction parallel to the tensioning direction produced by movement of the block, so the actuation of the block cannot secure the endoprosthesis against the projections or recesses, as claimed. Instead, in Moskovich the movement of the block 26 will push the endoprosthesis out of the insertion instrument. Furthermore, the Moskovich instrument does not have, and does not need, the claimed force-receiving part. Although the Examiner states that the "threaded rod (25) with a handle (21) ... could also function as a force-receiving part or 'strike head'," there is nothing in Moskovich that indicates that these parts can or should be used by a surgeon to receive implanting blows during an insertion procedure.

These are not incidental differences between Moskovich and the claimed invention, as explained at pages 2-3 of the specification of this application, as follows:

When the forceps-like insertion instrument is closed, the gripping members connected to one another via a hinge move toward one another and engage with a form-fit via their projections (or recesses) in corresponding depressions (or elevations) of the intervertebral endoprosthesis and thus tension the latter in a direction transverse to the longitudinal axis of the insertion instrument. The longitudinally movably guided block can be moved toward the intervertebral endoprosthesis until its abutment surface bears on the intervertebral endoprosthesis and secures the latter against the projections (or recesses). In this way, the intervertebral endoprosthesis is also tensioned in the longitudinal direction. It is thus held by the insertion instrument in a manner free of play and in a precise position. By virtue of the block bearing firmly on the intervertebral endoprosthesis, considerable forces, such as arise when striking the intervertebral endoprosthesis into place, can also be safely transmitted. Since these considerable forces are transmitted via the block and its abutment surface, the projections (or recesses) do not have to take up these forces. They can be of fairly small dimension and therefore made very fine, as is desired for precise positioning, without having to take into consideration the high force transmission when striking the intervertebral endoprosthesis home. In addition, by bearing on the intervertebral endoprosthesis, the block ensures that the latter does not inadvertently turn and that its individual elements do not open. By virtue of the invention, the intervertebral endoprosthesis can thus be held easily, safely and with precise positioning on the insertion instrument and inserted.

The Moskovich instrument works in a way that is entirely different from the claimed insertion instrument. The point of Moskovich is to allow for insertion of the prosthesis by pushing it out from the instrument along the grooved surfaces when the block is actuated; in this invention the actuation of the block tensions the prosthesis *against* the projections or recesses so that the surgeon inserting the prosthesis may use a hammer or the like against the force-receiving part to drive the prosthesis into its desired position while holding the prosthesis fast relative to the projections or recesses. Moskovich does not put persons of ordinary skill in the art in possession of applicant's invention and thus cannot anticipate his claims. Furthermore, Moskovich essentially teaches away from the claimed invention by disclosing an entirely different mode of operation, so Moskovich cannot, either by itself or in combination with the other cited prior art, render applicant's claims obvious because Moskovich does not provide the disclosures for which it is cited.

Early action allowing claims 1-17 is solicited.

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Respectfully submitted,

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